REMARKS

Claims 1 and 7 have been amended. Claim 6 has been canceled, and its subject matter incorporated into claim 1. Thus, claims 1-5 and 7 are now pending in the present application. Support for the amendment to claim 1 may be found in the specification at page 6, lines 17-29 and at page 8, lines 12-15. Support for new claims 8-9 can be found at page 8, lines 24-25. Thus, no new matter has been added. Reconsideration of the application in view of the amendments and comments presented herein are respectfully requested.

Rejection under 35 U.S.C. § 102(b)

Claims 1-5 and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by Bassett et al. (US 5,145,763). In order for a reference to anticipate a claim, all of the claim elements must be found within the reference. Claim 1 as amended recites that "the alkali soluble novolak resin before substitution by 1,2-naphthoquinone diazide sulfonyl groups has been fractionated by weight to produce a degree of dispersion of 2.2 to 2.8." The Bassett et al. does not even disclose that the material is fractionated by weight, much less that the resulting material has a degree of dispersion of 2.2 to 2.8. Thus, the claims cannot be anticipated by this reference. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. 102(b).

Rejections under 35 U.S.C. 103(a)

Claims 1-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Okazaki et al. (US 5,422,221) in view of Nishi et al. (5,759,736). The Examiner alleges that it would have been *prima facie* obvious to combine these references and reasonably expect same or similar results. However, as explained below, this combination of references would not render the claimed invention obvious.

Claim 1 as amended recites that that "the alkali soluble novolak resin before substitution by 1,2-naphthoquinone diazide sulfonyl groups has been fractionated by weight to produce a degree of dispersion of 2.2 to 2.8." This concept is neither disclosed not suggested by any of the cited references. Thus, no combination of these references would produce the claimed invention.

The nonobviousness of the presently claimed invention, in which fractionated resin is used, is further evidenced by the numerous advantageous results obtained thereby which could not have been expected in view of the prior art. As discussed in Applicants' specification at page 6, lines 26-29, "by using such fractionated resin, the perpendicularity of the resist pattern

sectional form becomes still better, the generation of a residual substance (scums) on the substrate after development decreases, and resolvability improves. Moreover, the resist becomes excelled in heat resistance." Further unexpected results are achieved by fractionating to the specific range of degree of dispersion recited in the claims, namely that "the resolvability, the perpendicularity of a resist pattern, and the heat resistance of the positive photoresist composition of the present invention improve." Specification at page 8, lines 13-15.

In view of the comments presented above, the cited prior art would not suggest the presently claimed invention. Moreover, the presently claimed invention provides a number of significant unexpected results which further evidence the nonobviousness of the claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a).

CONCLUSION

In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited. If any minor issues remain which could be resolved by telephone, the Examiner is invited to contact the undersigned at the number provided below.

Respectfully submitted,

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